

REMARKS

I. Introduction

Claims 1-36 stand rejected. Reconsideration of the application and allowance of all pending claims is respectfully requested in light of the following remarks.

Applicant thanks Examiner Layno for the courtesies extended to Applicant's representative, Andrew Reibman, Esq., during the telephonic interview of Nov. 6, 2006. An Interview Summary is attached at the end of this paper.

Several of the example embodiments of Applicant's invention solve problems related to losing instant lottery tickets that are incorrectly presented for redemption and winning instant lottery tickets that are not presented for redemption at all. Particularly with more complicated scratch-off games, some customers may not correctly understand the rules of the game, or may not properly recognize when a scratch-off ticket they have purchased is in fact a winning ticket. When customers present tickets for redemption that are not winners, this can be embarrassing for the customer who presented the ticket for redemption; it may also frustrate and waste the time of the retailer who has received the losing ticket for redemption. This may cause customers who are not sure they have a winning ticket not to present the ticket for redemption, resulting in winning tickets not being redeemed. For some instant ticket lotteries the percentage of winning tickets that are never redeemed is surprisingly high, and lottery authorities and the consuming public may view this negatively.

An affidavit of the inventor under Section 132 has been filed with the present paper which provides some additional background related to the problem of unredeemed instant lottery tickets. Included with the affidavit is an article relating to a recent situation where a million dollar winning instant ticket from the Massachusetts lottery was alleged to have been discarded by the ticket purchaser. The incident was publicized and resulted in a litigation over the ownership of the ticket. This article demonstrates the previously unsolved problem of unredeemed winning instant lottery tickets. Also included with the affidavit is a copy of an instant ticket believed to be the type of ticket that was the subject of the incident. An examination of the ticket will show that the ticket is substantially more complex than many more common instant lottery tickets. Applicant submits that the problem of unredeemed winning instant tickets increases with the use of more complex instant lottery tickets.

Applicant submits that the affidavit and annexed material evidences the long-felt need for Applicant's invention, and that this material should be considered in rebuttal to the Office's alleged *prima facie* case of obviousness.

Some of the example embodiments of the Applicant's invention, described in the specification, allow *players* to more easily recognize they have a winning ticket, even if they might not fully understand the rules of the game. This in turn may increase redemption rates for tickets that are actually winners and also reduce the frequency of non-winning tickets being presented for redemption. In particular, some example embodiments of Applicant's invention may include a pair of check codes *on the game ticket* which a player may match to determine if the ticket is a winning ticket, without completely analyzing the scratch-off game that is featured on the ticket. These codes, may also serve as a reminder or check for customers who incorrectly analyze the scratch-off game that is featured on the ticket or who are merely unsure if they have analyzed the scratch-off game correctly.

II. The "TPI Reference"

All of the rejections in the Office Action addressed herein rely on the "TPI" reference as the primary reference. As an initial matter, nothing in the Office Action sets out why the "TPI" non-patent document provided with the Office Action is alleged by the Office to be a prior art printed publication, where or by whom this document was obtained, or the circumstances which are alleged to constitute a publication of the document. Notwithstanding the copyright date or what is apparently a handwritten notation added by the Examiner to the face of the document, neither the document on its face nor any information provided with the document or in the Office Action establishes that the TPI document was a printed publication or the date of any alleged publication. It is also unclear if what has been presented constitutes the entire document, or merely a portion of the document. Accordingly, if the Office continues to rely on the document as a basis for a rejection, Applicant respectfully requests further information that provides a basis for the Office's contention that the document is a prior art printed publication. Given the absence of such supporting evidence, and to preserve all rights with respect to this issue, Applicant respectfully traverses all of the rejections relying on the TPI reference as well as the Office Action's contention that the "TPI" reference is prior art to the present application.

Moreover, nothing in the TPI reference teaches or suggests check codes for the use of *players*, let alone a pair of *player keys* that are provided *on the game ticket* for the use of players. The serial numbers provided in the TPI reference are intended for use by agents, and are intended to reduce fraudulent redemptions, not to aid players in identifying winning tickets. The TPI materials themselves indicate that the purpose of the TPI system is to reduce the amount payed out in improper redemptions, i.e. "to protect yourself [the game operator] and your profits". Applicant respectfully submits that the proposed modifications of the TPI reference, addressed in more detail in the following discussion, do not correct the deficiencies of the TPI reference or render any of Applicant's pending claims obvious.

III. U.S. Patent 4,174,857 to Koza

During the recent telephonic interview, the Examiner mentioned a further reference he had located, U.S. Patent 4,174,857 to Koza, but did not indicate whether or why he believed that the reference affected the patentability of the presently pending claims. The reference has been included on the Supplemental Information Disclosure Statement concurrently filed with this paper. However, upon review of the reference, Applicant does not believe that it renders any of the presently pending claims invalid either for either anticipation or obviousness. The Examiner's attention is drawn particularly to the "validation information" 22. This information appears to be duplicated on both Koza's "main portion 40" and on "the tab 42". However, nothing appears to teach or suggest that these two fields are not duplicated on losing tickets, or that these two copies of the validation information are intended to be compared to each other by a player for the purpose of identifying a winning ticket. Rather they appear to simply be two copies of the same validation code which may be entered into a validation system at different times, i.e., before and after the removal of the "void if removed" area. Moreover, these codes do not "visually indicate" a valid or winning ticket, but appear to be for entry into a conventional automated ticket validation system.

IV. Rejection of claims 1-6, 8-13, 16-23, 25, 28-32, 34 & 35 under 35 U.S.C. 103 over TPI in view of Such.

Claims 1-6, 8-13, 16-23, 25, 28-32, 34 and 35 stand rejected under 35 U.S.C. 103 over the "TPI" reference in view of Such.

Applicant respectfully submits that none of Applicant's pending claims are obvious over the TPI document, the Such reference, or their proposed combination. Applicant's claim 1 recites:

1. A game ticket, comprising
a substrate;
a game play area located on the substrate;
a customer key area located on the substrate;
a removable opaque covering applied to the substrate;

a first indicia visually indicating whether the game ticket is a winning ticket, the first indicia being located on the substrate within the game play area and concealed by the removable opaque covering; and
a second indicia visually indicating whether the game ticket is a winning ticket, the second indicia including

a first player key located on the substrate and concealed by the removable opaque covering; and
a second player key located on the substrate within the customer key area,

wherein whether the game ticket is a winning ticket is determinable using information from the first and second player keys in combination, but not determinable using only information from one of the first and second player keys.

The Office Action argues that the serial number printed on the so-called "check ticket" of the TPI cited reference should be moved to the "game ticket" of the TPI cited reference, based on the teachings of Such. In particular, the Office Action says this modification is taught by Such because "it is known to print various advertising indicia" on the substrate of pull-tab tickets.

As an initial matter, Applicant submits that, even if this modification of the TPI references were proper, it does not yield Applicant's claimed invention. The TPI reference appears to generally describe a "check ticket" which provides a list of serial numbers of all of the winning tickets in a pack of pull tab tickets. The codes in the TPI cited reference are not the recited player keys of Applicant's claim 1. Rather the TPI codes are intended for the user of sales agents in possession of a special check ticket. This check ticket is intended for use by an agent or clerk to screen tickets from the pack which are presented for redemption in an effort to reduce fraud and eliminate improper redemptions by the agent. Only one copy of the ticket serial number is provided on the TPI game ticket; the matching serial number does

not appear on the ticket. For winning tickets the matching serial number appears to be printed on the check ticket. Nothing in the TPI reference appears to teach or suggest in any way that *a player* would use the serial number provided on the game ticket or the matching serial number provided on the check ticket. Rather, the serial number appears solely intended for the use by a ticket redemption clerk or agent. Also, nothing in the TPI reference teaches or suggests in any way that the codes should be printed on the game ticket – rather they are printed on a separate “check ticket” which is not provided to players. Thus, the TPI serial number is not a “player key” and does not teach or suggest having two player keys on a game ticket which can be used together to determine if the ticket is a winner.

The Applicant believes that the term “player key” distinguishes the serial numbers used by agents in the TPI reference. As discussed during the telephonic interview, if it would facilitate the allowance of the present Application, the Applicant is willing to amend the claim recitation “wherein whether the game ticket is a winning ticket is determinable” to read “wherein whether the game ticket is a winning ticket is determinable by a player”. However, Applicant also believes that this feature is already implicit in the claim by the use of the term “player key”.

Some of the deficiencies of the TPI reference are recognized in the Office Action which attempts to remedy the deficiency of the TPI reference with a proposed combination with the Such patent (“Such”). Applicant respectfully submits that this combination of references is an improper hindsight reconstruction of Applicant’s claimed invention for at least three reasons: First, as noted above, the TPI serial numbers are not intended for use by a player. Second, even if Such teaches printing advertising indicia on a ticket, the TPI serial numbers are *not* advertising; Such does not teach or suggest printing codes from a separate check ticket on a player ticket. Therefore, Such does not teach the proposed modification of the TPI ticket. Third, the TPI cited reference teaches away from the proposed modification, which would completely eviscerate the apparent purpose of the check ticket in the TPI reference.

The cited Such patent does not teach the proposed modification. Even, for arguments sake, accepting that Such teaches exactly that ‘it is known to print various “advertising indicia” on the substrate of a pull-tab ticket’, as stated in the Office Action, the recited “player keys” are not “advertising indicia. In particular, Applicant disagrees with the

Examiner's characterization of the list of winning numbers on the "check ticket" in the TPI reference as an "advertising list". Such's "advertising" are dates and times of other unrelated games or other services. *See, e.g.*, Such Fig. 6 and Fig. 9. There is absolutely no teaching or suggestion in either reference that a list of winning serial numbers provided on a "check ticket" serves any advertising purpose – it does not even appear that the TPI "check ticket" is intended for use by game customers; rather the TPI code appears merely to be intended as an aid to ticket agents in screening tickets presented for redemption. As recited in Applicant's claim 1, the player keys have the novel and nonobvious feature that "whether the game ticket is a winning ticket is determinable using information from the first and second player keys in combination, but not determinable using only information from one of the first and second player keys". "Advertising indicia" in the context of Such does not have this property, and simply teaching adding "advertising indicia" would neither teach nor suggest providing a pair of player keys with the recited feature on a game ticket. For at least this reason, Such does not teach the proposed modification of the TPI reference, and the proposed combination of references does not render Applicant's claim 1 obvious.

Moreover, the proposed combination of Such and TPI is entirely contrary to the teaching and principles of operation of the TPI ticket. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *See* MPEP 2243.01 (*citing In re Ratti*, 270 F.2d 810 (CCPA 1959)). In the cited TPI materials, it appears that the game ticket is provided to the player. However the "check ticket" described in TPI does not appear to be provided to a player – rather it is a tool used by an agent to determine if tickets should be redeemed. This is apparent from the description in the TPI document which is directed to dealing with "When a ticket is presented", i.e. for redemption. The TPI "Check Ticket" appears to provide information, in a single source, that identifies all the different winning tickets in an entire book or pack of tickets. Moving this separate verification information directly to the ticket would eliminate the apparent purpose of having a separate verification means for winning tickets presented for redemption to an agent, and would also greatly increase the opportunities for fraud by the game players. If such information were provided on the game ticket, it could be altered by the person redeeming the ticket. Thus, the proposed modification entirely defeats the apparent purpose of the check ticket in the TPI reference. This teaches away from the

proposed modification set out in the Office Action. For at least this additional reason the proposed combination does not render claim 1 obvious.

Claims 2-6 and 8-13 all ultimately depend from claim 1. Therefore, they should be allowable for at least the same reasons as claim 1.

Moreover, claim 8 recites that the game play area and customer key area “are located separate and apart from one another on the substrate”. This feature is not present in either cited reference, and the proposed combination does not teach or suggest the recited feature. The TPI reference serial number appears to be located in the game play area, teaching away from the recited feature. Claim 8 thus should be allowable for at least this additional reason. Claim 10 recites that the customer key area is located entirely within the game player area. Even if TPI’s serial numbers from the “check ticket” were moved to the game ticket, nothing teaches or suggests that these codes should be located *entirely* within the game play area. Claim 10 thus should be allowable for at least this additional reason. Claim 11 expressly recites that at least one of the player keys is a non-numeric and non-alphabetic symbol. The cited serial numbers on the TPI check ticket do not satisfy the recited claim language. Claim 11 should therefore be allowable for at least this additional reason.

Claim 16 recites in part:

receiving a game ticket having a first indicia visually indicating whether the game ticket is a winning ticket and a first player key and a second player key, the first indicia and the first player key concealed by a removable opaque covering,

...
using information from the first player key and a second player key to visually determine if the game ticket is a winning ticket.

As discussed above in reference to claim 1, neither the TPI reference, Such, nor their combination, teach or suggest the use of the recited “player keys” on a game ticket, where the player keys have the recited property that they can be used to determine if the game ticket is a winning ticket. Therefore, claim 16 should be allowable over the cited references for reasons similar to those discussed above for claim 1.

Claims 17-21 ultimately depend from claim 16 and therefore should be allowable for at least the same reasons as claim 16.

Claim 22 recites that a game ticket is offered for sale that includes a first and second player keys that together allow the determination of whether the game ticket is a winning ticket. As discussed above for claim 1, this feature is not taught by the cited references, nor by their combination.

Claims 23, 25, 29-32 all ultimately depend from claim 22 and therefore should be allowable for at least the same reasons as claim 22.

Claim 34 similarly recites providing a “game ticket *to a player*”, the game ticket having a “first player key” and a “second player key” wherein “whether the game ticket is a winning ticket is determinable by the player” “based upon visual examination of the first and second player keys”. As discussed above for the other independent claims, this feature is neither taught nor suggested by the cited references, nor by their proposed combination. In particular, the TPI reference does not teach providing a game ticket *to a player* with the recited player keys. Furthermore, nothing in Such teaches that player keys should be provided to the game player, so the proposed combination of Such and the TPI reference does not remedy this deficiency of the TPI reference.

Claim 35 depends from claim 34 and therefore should be allowable for at least the same reasons as claim 34.

V. Rejection of claims 7, 24, 26, 27, 33, and 36 under 35 U.S.C. 103 over TPI in view of Such and in further view of Gerow.

Claims 7, 24, 26, 27, 33, and 36 stand rejected under 35 U.S.C. 103 over the “TPI” reference in view of Such and in further view of Gerow.

Claims 7, 24, 26, 27, and 36 all depend from claims already discussed above, and therefore should be allowable for at least the same reasons as their respective parent claims.

To the extent the Office Action relies on Gerow's bar code 22 as teaching a non-numeric and non-alphabetic symbol, the rejection is disagreed with because a bar code can not be used to "visually indicate" the ticket is a winning ticket as recited in claim 1, the parent of claim 7.

Claim 33 recites providing a ticket having a second indicia which includes a first and second player keys. Whether the game ticket is a winning ticket is determinable using information from the first and second player keys in combination. As discussed previously, this feature is not taught or suggested by the cited references or their proposed combination. The addition of Gerow does not eliminate the deficiency of the proposed combination of TPI and Such.

VI. Rejection of claims 14 and 15 under 35 U.S.C. 103 over TPI in view of Such and in further view of Koza.

Claims 14 and 15 stand rejected under 35 U.S.C. 103 over the "TPI" reference in view of Such and in further view of Koza.

Claims 14 recites the first and second player keys are located "on the substrate" of a "game ticket". As discussed above for claim 1, this feature is not taught or suggested by the Examiner's proposed combination of TPI and Such. Koza does not remedy this deficiency in the proposed combination. For at least this reasons, claim 14 is not obvious over the proposed combination of references and therefore should be allowable.

Claim 15 depends from claim 14, and therefore should be allowable for at least the same reasons as claim 14. Moreover, the Office Action does not identify the recited feature that the position of the first player key floats from game ticket to game ticket within the book of game tickets. This feature advantageously reduces the likelihood of pin pricking or other similar forms of fraud. Claim 15 should be allowable over the art of record for at least this additional reason.

VII. Conclusion

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited. The Examiner is invited to telephone Applicant's undersigned representative if any question arises concerning the present application.

Respectfully submitted,

~~KENYON & KENYON LLP~~



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